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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.				
10/642,608	08/19/2003	Christopher J. Ryan	8932-785-999	8166				
<div>51832 7590 07/26/2007</div> <div>JONES DAY 222 EAST 41ST STREET NEW YORK, NY 10017-6702</div>								
<div>EXAMINER</div> <div>PHILOGENE, PEDRO</div>								
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/642,608

Applicant(s)

RYAN, CHRISTOPHER J.

Examiner

Pedro Philogene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5,7-16 and 21-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-16,21-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5,7,8, are rejected under 35 U.S.C. 102(b) as being anticipated by Michelson (6,193,721).

Michelson discloses an apparatus awl (60), a shaft (64) with a cutting edge (65), an outer tapered sleeve (62), and a biasing member/spring (67), which biases the shaft (64) in the retracted position. The shaft is limited in its axial extension relative to the sleeve (62). The shaft is fully capable of being rotated relative to the sleeve since the sleeve and shaft are detachable. The distal end of the outer sleeve is sized and configured for releasable attachment to a bone plate; as set forth in column 23, lines 18-67; and as best seen in FIGS. 31, 32, 60, 61.

With respect to claims 2-5,7,8, Michelson discloses all the limitations; as set forth in column 23, lines 18-67, and as best seen in FIGS.31,32,60,61.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-16,21-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolf et al. (6,238,407) in view of Michelson (6,193,721).

Wolf et al disclose in FIG.1 a shaft (64) with a cutting edge (62), an outer sleeve (22), an inner sleeve (30) located between the shaft and the outer sleeve, a biasing member/spring (44) surrounds at least a portion of the shaft and is located in between the outer sleeve and the distal end of the inner sleeve, which biases the shaft (64) in the retracted position. The shaft is limited in its axial extension relative to the sleeve (64). The shaft is fully capable of being rotated relative to the sleeve since the sleeve and shaft are detachable. A top outer sleeve (24) having a through bore, a bottom outer sleeve (22) having a through bore.

Although the bottom outer sleeve of Wolf et al is fully capable of engaging an anchor plate, it is noted that Wolf et al did not teach of a shaft that can be rotated to aid in penetrating a bone; as claimed by applicant. However, in a similar art, Michelson evidences the use of a shaft that can be rotated within an outer sleeve that is sized and configured to releasably engage an anchor hole of a bone plate to aid in penetrating a bone thereby fixing the plate and the pilot hole forming apparatus together, assuring a stable fit between the pilot apparatus and the plate.

Therefore, given the teaching of Michelson, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Wolf et al, as taught by Michelson thereby fixing the plate and the pilot hole forming apparatus together, assuring a stable fit between the pilot apparatus and the plate.

With respect to the top outer sleeve being threaded to engage the bottom outer sleeve; since Wolf et al teach that the top and bottom outer sleeve are connected; the manner in which they are connected is irrelevant. Furthermore, the threads use by applicant is nothing more than one numerous connections of ordinary skill in the art would have found obvious for the purpose of providing connection surfaces to the top and bottom sleeves. A plurality of openings is seen in the top outer sleeve; as best seen in FIGS.4, 5 of Wolf et al. As to the plurality of openings in the bottom outer sleeve, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place openings in the bottom outer sleeve, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

### ***Response to Amendment***

Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pedro Philogene  
July 12, 2007

  
PEDRO PHILOGENE  
PRIMARY EXAMINER